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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

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BEFORE THE BOARD OF PATENT APPEALS
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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY E. JOHNSTON and ARIE LEVINKRON

DEC 15 2003
DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Appeal No. 2000-1719
Application No. 09/059,077

ON BRIEF

Before JERRY SMITH, RUGGIERO, and GROSS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 25, which are all of the claims pending in this application.

Appellants' invention relates to a mobile pan and tilt camera and display-control apparatus including a display-control box being attached to an adjustable mount in the vehicle within an operator's view and reach, and the box having an image display screen and control buttons for controlling the camera. Claim 1 is illustrative of the claimed invention, and it reads as follows:

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1. A mobile pan and tilt camera and display-control apparatus comprising:

a fully rotatable camera attached to a mount assembly that is mounted to a vehicle for capturing mobile images;

a display-control box having an image display screen and control buttons for controlling said camera and its movement, said display-control box being attached to an adjustable mount in said vehicle within an operator's view and reach;

an image capture box for receiving said captured images.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tovi	4,225,881	Sep. 30, 1980
Balkwill et al. (Balkwill)	4,408,695	Oct. 11, 1983
Yang	4,578,665	Mar. 25, 1986
Kennedy et al. (Kennedy)	4,695,881	Sep. 22, 1987
Baumeister	4,739,409	Apr. 19, 1988
McMahon	5,093,677	Mar. 03, 1992
Sergeant et al. (Sergeant)	5,107,286	Apr. 21, 1992
Lucas et al. (Lucas)	5,111,289	May 05, 1992
Kormos et al. (Kormos)	5,598,207	Jan. 28, 1997
Conway et al. (Conway)	5,652,849	Jul. 29, 1997
Klapper et al. (Klapper)	5,729,016	Mar. 17, 1998
Paddock et al. (Paddock)	5,737,657	Apr. 07, 1998
Schnee	5,751,344	May 12, 1998
		(filed Jul. 02, 1997)
Kurian	5,762,556	Jun. 09, 1998
		(filed Feb. 27, 1997)
Schilling et al. (Schilling)	5,873,557	Feb. 23, 1999
		(filed Aug. 11, 1997)

Claims 1 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable. As evidence of obviousness the examiner applies Schnee, Schilling, and Lucas for claims 1, 2, 5, 14, 18,

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19, and 24. To the combination of Schnee, Schilling, and Lucas, the examiner adds the following:

Paddock for claims 3, 4, 8, and 9,
Klapper for claims 6, 7, 21, and 22,
Kormos for claim 10,
Kormos and Kurian for claim 11,
Sergeant and Kennedy for claims 12 and 16,
McMahon for claim 13,
Baumeister for claim 15,
Balkwill for claim 17,
Tovi for claim 20,
Yang for claim 23, and
Conway for claim 25.

Reference is made to the Examiner's Answer (Paper No. 12, mailed March 14, 2000) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 11, filed December 20, 1999) for appellants' arguments thereagainst.

OPINION

As a preliminary matter we note that appellants indicate on page 9 of the Brief that claims 1, 2, 14, 18, 20, 24, and 25 are to stand or fall together, and that each of claims 3 through 13,

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15 through 17, 19, and 21 through 23 is to stand or fall separately. In accordance with 37 C.F.R. § 1.192(c)(7) and (8) appellants also have argued each of claims 1, 3 through 13, 15 through 17, 19, and 21 through 23 separately. Therefore, we will treat claims 1, 2, 14, 18, 20, 24, and 25 as a single group with claim 1 as representative, and we will treat each of the remaining claims individually.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejections of claims 1 through 25.

As to representative claim 1, appellants argue (Brief, pages 13-16) that none of the references teaches combining the camera controls and the display in the same box. Appellants contend (Brief, page 14) that Schnee's suggestion to locate camera controls "adjacent to" the monitor would not motivate one to combine the two in the same display box. Appellants (Brief, page 14) question why a skilled artisan would mount the camera controls and the display of Schnee in the same box rather than mount the camera controls based on physical accessibility by the user and the display based on visual accessibility by the user.

The examiner states (Answer, page 11) "[a]ccording to *In re Larson*, 144 USPQ 347 (CCPA 1965), integrating the claimed display-control box is not patentable. Making the display-control box integral does not produce an [sic] different result. Doing so is a matter of engineering choice." Appellants (Brief, pages 15-16) have attempted to distinguish over *In re Larson*. Specifically, appellants explain that in *In re Larson* "two functionally-related parts that are rigidly secured together in the prior art . . . [are] claimed as an integrated unit in the application." On the other hand, in the present case, appellants assert that no prior art discloses the camera controls and the display being secured together. Appellants, therefore, conclude (Brief, page 16) that *In re Larson* "provides no legal precedent for concluding obviousness in the present case."

The examiner has not indicated how the facts of this case correspond to those of *In re Larson* nor addressed the differences pointed out by appellants. Case law should not be cited as a *per se* rule without applying the facts. Since the examiner provides no evidence of obviousness for the integration of the display and the camera controls in a single box, relies on *In re Larson* without applying the facts of this case thereto, and fails

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to address the arguments provided by appellants, we cannot sustain the rejection of claim 1, and the claims grouped therewith, claims 2, 14, 18, and 24, over Schnee, Schilling, and Lucas. In addition, since none of the additional references overcomes the deficiencies noted as to claim 1, we likewise sustain the rejections of claims 3 through 13, 15 through 17, 19 through 23, and 25.

We note that for many of the dependent claims the examiner points to where the element recited in each claim can be found in an additional reference (Tovi, Balkwill, Yang, Kennedy, Baumeister, McMahon, Sergeant, Kormos, Conway, Klapper, Paddock, or Kurian), but fails to point to any teaching in that reference as to why the skilled artisan would have used the element in the structure of the primary combination. Merely that another has used an element is insufficient motivation for combining it with other devices. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Furthermore, regarding the examiner's response to arguments, merely repeating the rejection (see, for example, Answer, pages 15 and 18) or, worse yet, referring appellants to an Office

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